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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,686	05/02/2005	Eiji Sugiyama	4777-62	6113
29540	7590	12/09/2009		
DAY PITNEY LLP 7 TIMES SQUARE NEW YORK, NY 10036-7311				
EXAMINER RIVIERE, HEIDI M				
ART UNIT		PAPER NUMBER		
3689				
NOTIFICATION DATE		DELIVERY MODE		
12/09/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/533,686

**Applicant(s)**

SUGIYAMA ET AL.

**Examiner**

HEIDI RIVIERE

**Art Unit**

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11, 20, 42, 43, 54 and 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 20, 42, 43, 54 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed **6 November 2009** have been fully considered but they are not persuasive. Applicant argues the claims as currently amended teach that an eco value is derived from the production of the organic product. However, Helminen teaches a value added equation with inventory variable as well as taxes and other factors that go into producing a product, used in cost production unit level. As a result value is calculated based on the production information. Furthermore, the McMorris reference used in claim 42 teaches that it was old and well known in the art to have protocols that use "IPCC Global Warming Potential (GWP) conversion factors (to enable equivalent comparison of different greenhouse gases in terms of carbon dioxide equivalents)". As a result the rejection is not withdrawn.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 11, 20, 42-43 and 54-55** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In regards to claims 11, 20, 42-43 and 54-55, these claims merely present a compilation of data and computation performed by a software program. In regards to these claims, computer

programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. The claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claim 42** are rejected under 35 U.S.C. 102(e) as being anticipated by **McMorris, III et al. (US 2004/0230443)** (hereinafter “**McMorris**”).

6. **With respect to claim 42:** (new) **McMorris** teaches converting an environmentally-friendly value index of plant-based resource, in terms of that of fossil-based resource, for communicating the environmental friendly value between a potential seller and a potential buyer. (paragraphs 59-62 - protocol uses “IPCC Global Warming

Potential (GWP) conversion factors (to enable equivalent comparison of different greenhouse gases in terms of carbon dioxide equivalents)”)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 11, 20, 54 and 55** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Leslie Webb, “Sticking to the Requirements of Eco-labels”,** PPI, Oct. 2000, Vol. 42, Iss. 10, page 39 (hereinafter “**Webb**”) in view of **Riina-Riitta Helminen, “Developing Tangible Measures for Eco-Efficiency: The Case of the Finnish and Swedish Pulp and Paper Industry”,** Business Strategy and the Environment, May/June 2000, page 196 (hereinafter “**Helminen**”).

9. **With respect to claims 11 and 55: (Currently Amended)** Webb teaches:

- First computing means for computing a production volume of the organic compound product produced using the plant-based resource; (Webb: page 2, paragraphs 5-8 – “manufacturer must calculate the reference consumption of fuels and imported electricity for on-site processes (for data provided) and then calculate its own electricity and fuel consumption”  
The CO<sub>2</sub> emissions calculate based on the production of virgin pulp for paper; levels of carbon dioxide emissions determined)

- A third computing means for computing a production volume of the organic compound product produced using the fossil based resource corresponding to the environmentally-friendly value-index. (pages 2-3 – eco-label for printing paper, covers woodfree and wood containing papers; "manufacturer must calculate the reference consumption of fuels and imported electricity for on-site processes"; levels of carbon dioxide emissions determined)

Webb teaches the limitation in the rejection above however while Webb does not teach, Helminen teaches:

- A second computing means for computing an environmentally-friendly value index, which is an index for environmentally-friendly value, based on a production volume of the organic compound product produced using the plant-based resource; (pages 198-199 – value added equation with inventory variable as well as taxes and other factors that go into producing a product, used in cost production unit level)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Webb and Helminen and have a label on a product to signify that it falls within an environmentally-friendly value index. This details the environmental impact and effect of the product. Furthermore, CO2 calculation can be based on the result of plant or fossil based production.

10. **With respect to claim 20:** (previously presented) Webb teaches a step of acquiring certification request information, the gist of which is a request for certification

of a labeling right; a step of outputting certification information including information on a corresponding production volume, based on the certification request information acquired in the step of acquiring certification request information; a step of acquiring transfer request information, the gist of which is a request for transfer of the labeling right received in correspondence with the output of the certification information according to the step of outputting said certification information; step of acquiring acceptance request information, the gist of which is a request for acceptance of the labeling right; and a step of comparing the transfer request information acquired in the step of acquiring said transfer request information, and the acceptance request information acquired in the step of acquiring acceptance request information. (pages 1-5 – eco-label for printing paper, covers woodfree and wood containing papers; “manufacturer must calculate the reference consumption of fuels and imported electricity for on-site processes”; levels of carbon dioxide emissions determined; threshold of CO<sub>2</sub> also determined in regards to the application of the label; pulps must be ‘derived from forests that have been certified by an approved system such as the Swedish FSC standard’)

11. **With respect to claim 54: (new)** Webb teaches:

- a first computing means for computing a **production volume** of the first organic compound and an amount of plant-based resource and an amount of fossil based resource used in producing the first organic compound, (Webb: page 2, paragraphs 5-8 – “manufacturer must calculate the reference consumption of fuels and imported electricity for on-site

processes (for data provided) and then calculate its own electricity and fuel consumption” The CO<sub>2</sub> emissions calculate based on the production of virgin pulp for paper; levels of carbon dioxide emissions determined)

- a second computing means for computing an environmentally-friendly value index from the production volume of the first organic compound, the amount of plant based resource and the amount of fossil based resource used in producing the first organic compound, and the production method utilized in producing the first organic compound, (Webb: page 2, paragraphs 5-8 – “manufacturer must calculate the reference consumption of fuels and imported electricity for on-site processes (for data provided) and then calculate its own electricity and fuel consumption” The CO<sub>2</sub> emissions calculate based on the production of virgin pulp for paper; levels of carbon dioxide emissions determined) and

Webb teaches the limitation in the rejection above however while Webb does not teach, Helminen teaches:

- a third computing means for computing a production volume of a second organic compound corresponding to the environmentally-friendly value-index. (Helminen: pages 198-199 – value added equation with inventory variable as well as taxes and other factors that go into producing a product, used in cost production unit level)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Webb and Helminen and have a label on a



product to signify that it falls within an environmentally-friendly value index. This details the environmental impact and effect of the product. Furthermore, CO2 calculation can be based on the result of plant or fossil based production.

12. **Claim 43** is rejected under 35 U.S.C. 103(a) as being unpatentable over **McMorris** in view of **Sandor et al. (US 2006/0184445)** (hereinafter "**Sandor**").

13. **With respect to claim 43:** (new) McMorris teaches the limitations in claim 42 cited in the rejection above. However, while McMorris does not Sandor teaches certifying the environmentally-friendly value index by a third party other than the potential seller and the potential buyer. (paragraphs 140, 220 – renewable energy certificates integrated into system)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Sandor and McMorris. McMorris details a system used in the trading of carbon credits and conversion factors used to determine carbon dioxide equivalents. Sandor also teaches a carbon credits trading system however it details that these credits can be certified.

### **CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. R./  
Examiner, Art Unit 3689

/Dennis Ruhl/  
Primary Examiner, Art Unit 3689